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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

DENNISON, JERRY B

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2143

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Technology Center 2100

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/804,607
Filing Date: March 12, 2001
Appellant(s): CHERRY, DARREL D.

Jack H. McKinney
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 20 December 2006 appealing from the Office action mailed 31 May 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,738,841	Wolff	5-2004
2002/0085515	Jaynes et al.	7-2002

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Interpretation

Claims 8, 12, and 15 recite optional clauses that do not further limit the claims.

Claim 8 recites the limitation, "such that the user may be identified as...", i.e. the user may be, but its not required.

Claim 12 recites the limitation, "such that said remote print request system is able to receive...", i.e. the system is able to, but it is not necessary.

Claim 15 recites the limitation, "such that said remote print system is able to receive...", i.e. the system is able to, but it is not necessary.

Any language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See MPEP 2106, section II, subsection C for specific examples.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 11-13, 15, 16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (U.S. 6,738,841).

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1. Regarding Claim 11, Wolff disclosed a print system for use with an Intranet, (Col. 4, lines 56-64 & Col. 5, lines 26-30), in which printers may be directly coupled to a local area network (LAN) or a wide area network (WAN) (Wolff, col. 4, lines 55-65, a LAN is an Intranet, a WAN is an Internet). Wolff also disclosed that client 210 requests documents from servers 220 and 230 coupled to the network (Wolff, col. 5, lines 33-36).

As explicitly disclosed by Wolff, "client 210 may transmit a document request directly to server 220 or 230. Subsequently, the servers 220 and 230 transmits the document data to printer server 255 where the document handling operations and formatting are implemented" (Wolff, col. 6, lines 64-67). Wolff also disclosed, "For example, requests from client 210 may be received at server 220 and 230 wherein all of the document handling and formatting operations are performed prior to transmitting the document data to printer 250 for download (Wolff, col. 7, lines 4-9).

Wolff also disclosed that the network as used in the present invention is not just limited the Internet but the teachings may be applied to "various networks" (Wolff, col. 5, lines 25-33).

Wolf did not explicitly state wherein the client 210 and servers 220 and 230 are coupled via an Intranet.

However, Wolff disclosed that the teachings of the invention are not limited to just the Internet, but may be applied to "various networks," one of ordinary skill in the art would have been motivated to apply various well-known network types to use for the network of Wolff. Since Wolff also disclosed the use of local area networks (LAN's), Wolff shows that LAN's were well known types of networks.

Therefore it would have been obvious for one of ordinary skill in the art at the time the invention was made to use a LAN as the network to provide an Intranet between client 210 and servers 220 and 230 for the benefit of providing network administrators with the ability to make and/or use the invention without having to "reinvent the wheel."

Therefore, Wolff disclosed a client transmitting a document printing request to a server for a specific document requested by a client, both the client and the server may be coupled on an Intranet (Wolff, col. 5, lines 29-30, i.e. not limited to just the Internet, also includes "various networks"; One of ordinary skill would interpret "various networks" to include a LAN, since a LAN was clearly well known and shown by Wolff at col. 4, lines 61-62). Subsequently, Wolff disclosed the server transmitting the document to a printer server 255. Wolff clearly disclosed that the printer could act as a World Wide Web (WWW) server (Wolff, col. 4, lines 55-65), meaning requests may be sent along the Internet to the printer. As shown in Figure 2, the printer 250 is coupled to a print server 255. Therefore, Wolff disclosed that the client may send a document request via the Intranet to the server, and the server sends the request via the Intranet and then via the Internet to the print server 255.

Therefore, Wolff disclosed a print system doe use with an intranet, the intranet being configured to store information corresponding to documents available for printing (Fig. 9 & Col. 2, lines 29-62), said print system comprising:

a document retrieval system communicatively coupled with the intranet (Wolff, Fig. 2, Server 220 or Server 230), said document retrieval system being configured to

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receive document reference information corresponding to a document to be printed and printer information corresponding to a network printer that is coupled to the intranet via the internet (Wolff, col. 6, lines 64-67, Wolf disclosed the client requesting a document to be printed at the print server, the request received by server 220 or 230; col. 5, lines 55-60, The request includes document reference information so the server knows what document to transmit to the printer, the request specifies what is to be done with the document, which is, send it to printer 255 to be printed) and,

in response thereto, provide print information corresponding to the document to be printed to the network printer via the Internet such that the network printer prints the document (Wolff, col. 5, lines 55-60, The request includes document reference information so the server knows what document to transmit to the printer, the request specifies what is to be done with the document, which is, send it to printer 255 to be printed); and

a remote print request system (Fig. 2, client 210) configured to communicatively couple with said document retrieval system (Fig. 2, network 200 coupling client and server), said remote print request system being further configured to retrieve printer information corresponding to the network printer, the printer information including a network address for the network printer (Wolff, col. 6, lines 55-60, Wolff disclosed the client having the ability to communicate with the printer, which would require the client to contain the network address of the printer, otherwise, it would not be able to communicate with the printer), to receive document reference information corresponding to documents available for printing via the Intranet (Wolff, col. 6, lines 55-

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64, Wolff disclosed the user may specify that the printer server organize and print compound documents, by allowing the user to specify documents to be printed in a specific order, i.e. levels of linked documents), store the document reference information remotely from the Intranet (Wolff, col. 5, lines 65-67, Wolff disclosed that the print server may be used as storage, therefore storing the documents for reference), enable selection by a user of a document to be printed (Wolff, col. 6, lines 55-60, Wolff disclosed the user specifies the documents to be printed), and provide the printer information and the document reference information corresponding to a document selected to be printed to said document retrieval system such that the document retrieval system communicates the information corresponding to the document to the network printer without further use of the remote print request system (Wolff, col. 6, lines 64-67, Wolff disclosed the client having the ability to communicate through server 220 or 230 to transmit document printing request, which, as explained above, would require the printer information to be communicated along with the request in order for the server to interpret the request).

Claim 21 includes a method for remotely printing a document. The print system of claim 11 clearly accomplishes this method substantially as claimed. Claim 21 further recites that the client is a personal digital assistant (PDA). Wolff clearly disclosed a PDA 930 accessing a server 920 (Wolff, see Abstract, Fig. 9, PDA 930, col. 8, lines 53-55). Therefore, claim 21 is rejected under the same rationale as claim 11.

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2. Regarding claim 6, Wolff disclosed the limitations, substantially as claimed, as described in claim 21, including wherein the step of receiving printer information comprises the step of receiving IP address information corresponding to the network printer (Wolff, col. 6, lines 55-60, Wolff disclosed the client having the ability to communicate with the printer, which would require the client to contain the IP address of the printer, otherwise, it would not be able to communicate with the printer).

3. Regarding claim 12, Wolff disclosed the limitations, substantially as claimed, as described in claim 11, including wherein said remote print request system is configured to communicatively couple with a network printer such that said remote print request system is able to receive the printer information corresponding to the network printer and provide said document retrieval system with the printer information (Wolff, Fig. 2, servers 220 and 230 coupled to printer 250/printer server 255).

4. Regarding claim 13, Wolff disclosed the limitations, substantially as claimed, as described in claim 11, including wherein said remote print request system is implemented in a personal digital assistant (col. 8, lines 50-55).

5. Regarding claim 15, Wolff disclosed the limitations, substantially as claimed, as described in claim 11, including wherein said remote print request system comprises means for communicatively coupling with a network printer such that said remote print

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request system is able to receive printer information corresponding to the network printer (Wolff, Fig. 2, servers 220 and 230 coupled to printer 250/printer server 255).

6. Regarding claim 16, Wolff disclosed the limitations, substantially as claimed, as described in claim 11, including wherein said documents retrieval system comprises means for retrieving print information corresponding to a document to be printed in response to receiving document reference information from said remote print request system (Fig. 9; col. 8, lines 32-67; col. 9, lines 1-30).

Claims 8, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (U.S. 6,738,841) in view of Jaynes et al. (U.S. 2002/0085515).

7. Regarding claims 8, 9, and 14, Wolff disclosed the limitations, substantially as claimed, as described in claim 21, including wherein access is permitted to documents over a network (Col. 5, lines 25-39).

Wolff did not explicitly state further comprising the step of receiving an authorization code, and wherein the step of providing printer information comprises the step of providing the authorization code to the intranet such that the user may be identified as being authorized access to request printing of a document at the network printer, wherein the step of receiving an authorization code comprises the step of storing the authorization code with the PDA

Jaynes disclosed receiving, storing and providing an authorization code via the PDA, wherein the step of providing information comprises the step of the retrieval system providing the authorization code to the intranet, such that the user may be identified as being authorized access (Jaynes – paragraph #0031).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the authentication of Jaynes into the teachings of Wolff in order to provide information to a user, (PDA over a network), which information is relevant to a specific physical object in the vicinity of the user, (i.e.: bank account, etc.), (paragraph #006). Examiner notes that user, (i.e.: bank account, etc.) information is well known to be private information requiring a secure transmission/transfer process. Additionally, Examiner notes that as a PDA has a memory/storage capability, storage of an authorization code on the PDA would have been obvious for purposes of security and access authorization when transmitting/receiving from a remote location.

(10) Response to Argument

A. 1. Applicant argues, "Wolff failed to teach or suggest a method in which information for printing the document is communicated from the document retrieval system to the network printer via the intranet and the internet." [see Applicant's arguments, page 6]

Applicant asserts that, "Examiner mistakenly equates Wolff's printer server (255) with the document retrieval system recited in Claim 21" [page 7, first paragraph].

Examiner respectfully disagrees.

As shown in the above rejection, Examiner equates server 220 or server 230 as the document retrieval system of the claimed invention (Wolff, Fig 2, servers 220 and 230).

Client 210 and servers 220 and 230 on an Intranet

Wolff disclosed that the client-server network is not just limited the Internet but the teachings may be applied to "various networks" (Wolff, col. 5, lines 25-33).

Wolf did not explicitly state wherein the client 210 and servers 220 and 230 are coupled via an Intranet.

However, one of ordinary skill in the art would have been motivated to apply various well-known network types to substitute for the network of Wolff. Since Wolff also disclosed the use of local area networks (LAN's), Wolff shows that LAN's were well known types of networks.

Printer 250/Printer Server 255 on an Internet

Wolff disclosed a print system for use with an Intranet, in which printers may be directly coupled to a local area network (LAN) or a wide area network (WAN) (Wolff, col. 4, lines 55-65, a LAN is an Intranet, a WAN is an Internet, Col. 5, lines 26-30). Wolff clearly disclosed that the printer could act as a World Wide Web (WWW) server (Wolff, col. 4, lines 55-65), meaning requests may be sent along the Internet to the printer. As shown in Figure 2, the printer 250 is coupled to a print server 255. From these mappings, it is clear that the printer 250/printer server 255 may either be located on the LAN with the client 210 and servers 220 and 230, or on a WAN that is connected to the LAN.

Communication through the Intranet and the Internet

As explicitly disclosed by Wolff, "client 210 may transmit a document request directly to server 220 or 230. Subsequently, the servers 220 and 230 transmits the document data to printer server 255 where the document handling operations and formatting are implemented" (Wolff, col. 6, lines 64-67). Wolff also disclosed, "For example, requests from client 210 may be received at server 220 and 230 wherein all of the document handling and formatting operations are performed prior to transmitting the document data to printer 250 for download (Wolff, col. 7, lines 4-9).

Therefore the client transmits a request to the server, and then the server transmits the requests including the document data to the printer server/printer. With the server located on the Intranet (LAN, as explained above), and the printer/printer server located on the Internet (WAN, as explained above), clearly any communication

from the server 220 to the printer server 250 must be transmitted via the Intranet, and then via the Internet.

A. 2. Applicant argues the failure of Wolff to disclose the same functionality wherein the client is a PDA [See Applicant's arguments, page 7, last paragraph].

Examiner respectfully disagrees.

The PDA of Wolff is found in a nonpreferred embodiment. In another embodiment, Wolff disclosed a substantially similar system in which the client device is a PDA (Wolff, Fig. 9, PDA 930).

Wolff disclosed the clients in the system typically include a client processor and a memory and a computer readable medium storing instructions. It is well known in the art that a PDA includes a processor, memory, and a computer readable medium for storing instructions. Therefore, It would have been obvious to one of ordinary skill in the art to substitute the client 210 of Figure 2 with the PDA 930 of Fig. 9 since Wolff disclosed the PDA in a nonpreferred embodiment. MPEP 2123 states, "A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989)."

A. 3. Applicant argues, "Wolff failed to teach or suggest a document retrieval system communicatively coupled with the intranet that is configured to receive document

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reference information corresponding to a document to be printed and printer information corresponding to a network printer that is coupled to the intranet via the Internet" [see Applicant's arguments, page 9].

Applicant reasserts, "Examiner is apparently equating Wolff's printer driver/server (255) with the document retrieval system recited in claim 21" [see Applicant's arguments, page 9].

Examiner respectfully disagrees.

As explained above, Examiner equates server 220 and 230 to the document retrieval system of the claim.

As explained above, server 220 or server 230 is communicatively coupled with client 210 on the intranet (Fig. 2, also explained above). As explicitly disclosed by Wolff, "client 210 may transmit a document request directly to server 220 or 230. Subsequently, the servers 220 and 230 transmits the document data to printer server 255 where the document handling operations and formatting are implemented" (Wolff, col. 6, lines 64-67). Wolff also disclosed, "For example, requests from client 210 may be received at server 220 and 230 wherein all of the document handling and formatting operations are performed prior to transmitting the document data to printer 250 for download (Wolff, col. 7, lines 4-9).

B. Claims 8 and 9 depend from claim 21 and 14 depends from claim 11. Applicant did not provide any further arguments regarding claims 8, 9, and 21. Therefore the rejections of these claims are maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




J. Bret Dennison

Conferees:



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100



WILLIAM VAUGHN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100